

124. A method of producing recombinant protein<sup>in</sup> embryonic stem cells in serum-free culture, said method comprising

(a) obtaining a recombinant embryonic stem cell containing a nucleic acid molecule which encodes a protein of interest;

(b) culturing said embryonic stem cell in serum free culture to form a population of recombinant embryonic stem cells; and

(c) isolating said protein from said embryonic stem cells or from the medium in which said cells are cultured.

125. The method according to claim 124, wherein said isolating ~~further~~ comprises

(c1) isolating said protein from said embryonic stem cells.

126. The method according to claim 124, wherein said isolating ~~further~~ comprises

(c1) isolating said protein from said harvested medium.--

### Remarks

#### ***I. The Present Divisional Application Is Co-Pendent With the Parent Application***

The present application is a divisional of parent application no. 08/781,772, filed January 10, 1997. A final Office Action was mailed January 5, 1999 in the parent. The Patent Office was closed on July 5, 1999, for the July 4<sup>th</sup> holiday, so on July 6, 1999,

Applicants filed an Amendment and Reply, a Petition for Extension of Time, a Notice of Appeal, and paid the requisite extension and notice of appeal fees.

September 5, 1999 fell on a Sunday. The Patent Office was closed on Monday, September 6, 1999, for the Labor Day holiday. Because the parent application is pending today, September 7, 1999, the present divisional application is co-pendent with the parent application.

## ***II. Status of the Claims***

Claims 1-88 have been canceled without prejudice to or disclaimer of the subject matter therein. Claims 89-126 have been added. Claims 89-126 are pending in the present application.

## ***III. Support For The Amendment***

In the Office Action mailed October 2, 1997 in the parent application, the Examiner confirmed the restriction requirement, in which claims 43-55, 68-79 and 85-88 were grouped in Group II. In the Amendment and Reply filed in the parent on October 22, 1998, Applicants added new claims 108-144. In the Office Action mailed in the parent on January 5, 1999, the Examiner explained that claims 102-144 had been entered, and that claims 140 and 141 had been grouped in Group II. The Examiner also confirmed that Group II included claims 43-55, 68-79, 85-88, 140 and 141.

Some of the claims in Group II of the parent application depend from claims that are not being prosecuted in the present divisional application. For example, claim 43 depended from claims 26 or 34. Accordingly, Applicants have rewritten claims 43-55, 68-

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79, 85-88, 140 and 141 as claims 91-126. New claims 91-126 correspond to and find support in claims 43-55, 68-79 and 85-88 as filed originally.

New claim 89 corresponds to claim 140 in the parent application, and support for new claim 89 is found in the specification at page 5, lines 6-11; page 9, lines 26-27; page 31, lines 4-6; and page 31, lines 17-19.

New claim 90 corresponds to claim 141 in the parent application, and support for new claim 90 is found in the specification at page 20, lines 8-11; page 38, lines 13-28; and page 42, line 8.

No new matter has been added by this amendment. Entry of this amendment is respectfully requested.

### ***Conclusion***

The present application is in condition for examination. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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